

U.S. Patent Application No. 09/833,433
Attorney Docket No. 13DV13926 (07783-0074)

REMARKS

The Office Action mailed November 17, 2004 has been received and carefully considered. Upon entry of the present amendments, claims 1-3, 6-16, and 18-20 will be pending. In the Office Action, Claim 2 stands rejected under 35 U.S.C. §112, 2nd paragraph. Claims 1, 10, 11, 14 and 20 stand rejected under 35 USC §102(e) as anticipated by U.S. Patent 6,327,628 to Anuff et al. (Anuff). Claims 2-4, 6-9, 12-13, 15-16 and 18-19 stand rejected under 35 U.S.C. § 103(a) as obvious over Anuff. Claims 5 and 17 stand rejected under 35 U.S.C. § 103(a) as obvious over Anuff in view of the Examiner's Official Notice. Claim 9 is objected to in view of an informality.

I. Amendments to the Claims.

Claims 1-2, 6-7, 9, 11, and 14 are amended. Claims 4, 5 and 17 are cancelled without prejudice. Support for the amendments is found at least at paragraphs [0034] to [0037] of the specification as originally filed. No new matter is presented.

II. Objection to Claim 9.

Claim 9 was objected to for containing an informality resulting from a typographical error. Claim 9 has been amended to correct the error in a manner believed to overcome the objection.

III. Rejection under 35 U.S.C. §112, 2nd paragraph.

Claim 2 stands rejected under 35 U.S.C. §112, 2nd paragraph as indefinite for failing to recite sufficient antecedent basis for the limitation "the organization" in the last line. Applicants respectfully submit that the claim was definite as originally filed and remains so. One of ordinary skill in the art would readily appreciate that "the organization" referred to in the last line of the claim is the antecedent "organization associated with the user" used throughout the claim.

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Nevertheless, to advance the prosecution of the case, Applicants have amended claim 2 to specifically and fully recite "the organization associated with the user."

IV. Rejection under 35 U.S.C §102(e).

Claims 1, 10, 11, 14 and 20, of which claims 1, 11 and 14 are independent, stand rejected under 35 USC §102(e) as anticipated by Anuff. Applicants respectfully traverse the rejection.

It is well established that to anticipate an invention, a reference must teach each and every element of the claimed invention, either explicitly or inherently. *In re Schreiber*, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Anuff, as understood, is directed to a portal server that presents an HTML page that has a plurality of modules formatted in a predetermined layout. Abstract. At the user interface level, the portal server presents an initial view that includes a plurality of modules positioned in a predetermined layout. Each module is a resource of a particular type that can be accessed by a user. Some modules are user selectable, while others are mandatory. Col. 2, lines 1-8.

Claim 1 as amended is directed to a system for a user to access information and applications on a network. The system comprises a server computer comprising a processor and a storage device; a client computer connected to the server computer; and a portal stored in the storage device of the server computer and accessible by the user on the client computer, the portal being configured to provide access to information and applications on a network. The portal comprises a plurality of sections, wherein each section of the plurality of sections comprising means for providing access to a particular type of information or application stored on the network; and means for the user to personalize at least one section of the plurality of sections to provide the user with access to particular information and applications related to the at least one section of the plurality of sections as selected by the user, wherein at least one

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section of the plurality of sections comprises means for the user to select at least one module for the section being personalized. The means for the user to select at least one module comprises means for filtering modules to generate a list of modules, means for previewing a module from a list of modules, and means for selecting a module from a list of modules.

Claim 11, as amended, is directed to a portal for a user to obtain access to information and applications stored at a plurality of locations. The portal comprises a plurality of sections, wherein each section of the plurality of sections being directed to a group of related information sources and applications stored at a plurality of locations, and each section of the plurality of sections comprising means for providing access to the corresponding group of related information sources and applications, and means for the user to personalize at least one section of the plurality of sections to provide the user with access to particular information sources and applications in the group of related information sources and applications designated by the user wherein at least one section of the plurality of sections comprises means for the user to select at least one module for the section being personalized. The means for the user to select at least one module comprises means for filtering modules to generate a list of modules, means for previewing a module from a list of modules, and means for selecting a module from a list of modules.

Claim 14, as amended, is directed to a computer program product embodied on a computer readable medium and executable by a computer for a user to obtain access to information and applications stored at a plurality of locations. The computer program product comprises a plurality of sections, wherein each section of the plurality of sections being directed to a group of related information sources and applications stored at a plurality of locations, and each section of the plurality of sections comprising means for providing access to the

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corresponding group of related information sources and applications, and means for the user to personalize at least one section of the plurality of sections to provide the user with access to particular information sources and applications in the group of related information sources and applications designated by the user wherein the means for the user to personalize at least one section of the plurality of sections comprises means for the user to select at least one module for the section being personalized. The means for the user to select at least one module comprises means for filtering modules to generate a list of modules, means for previewing a module from a list of modules, and means for selecting a module from a list of modules.

The independent claims, as amended, incorporate the limitations of now-cancelled claims 4 and 5, also found in the corresponding (also cancelled) claim 17. At the very least, Anuff fails to disclose means for previewing a module from a list of modules as already admitted by the Examiner. Office Action at page 8. Thus, as admitted by the Examiner, the claims as amended are not anticipated as they fail to teach each and every limitation of the claimed invention as found in independent claims 1, 11 and 14.

As amended, each of independent claims 1, 11 and 14 contains the limitations "means for filtering modules to generate a list of modules" and "means for previewing a module from a list of modules," both of which were found in claims 5 and 17 as originally filed. Claims 5 and 17 were rejected under 35 U.S.C. § 103(a) as obvious over Anuff in view of the Examiner's Official Notice, the limitations of which claims now appear in independent claims 1, 11 and 14. Applicants respectfully traverse this rejection to the extent it applies to the limitations as found in the amended independent claims.

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The Examiner has relied upon Official Notice in combination with Anuff to assert that it would have been obvious to one of ordinary skill in the art to modify Anuff to include a means for previewing a module from the list of modules. Office Action at page 8.

An Examiner may take Official Notice only in cases where the alleged fact to be noticed can be instantly and unquestionably demonstrated as well-known. MPEP §2144.03. Applicants respectfully traverse the Official Notice as not properly based. Without making any admissions as to whether the Examiner's Official Notice would be appropriate for a more recently filed application, Applicants submit that as of the instant Application's filing date, well over three and one half years ago, the Examiner cannot say that a means for previewing a module from a list of modules was so well known as to be instantly and unquestionably recognized in the absence of any supporting reference. The Examiner is requested to provide the supporting references showing that Applicants' recited features are well established in the art. Applicants further submit that even if such a reference were available, Anuff has provided no motivation nor a desirability to incorporate a preview feature corresponding to Applicants' claimed invention.

As the Federal Circuit has recently admonished,

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. *Env'tl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 [218 USPQ 865] (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.

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Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided further assurance of an "as a whole" assessment of the invention under §103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination. *See In re Rouffet*, 149 F.3d 1350, 1355-56 [47 USPQ2d 1453] (Fed. Cir. 1998).

Ruiz v. A.B. Chance Co., 69 USPQ2d 1686, 1690 (Fed. Cir. 2004)

In the context of the instant Application, even assuming, *arguendo*, that the Examiner were to establish that Anuff teaches all of the claim limitations except the previewing feature and found a second reference that teaches a previewing feature, simply declaring the invention obvious because all features are present, absent some motivation to combine those references, relies on impermissible hindsight.

In addition to failing to disclose means for previewing modules, Anuff also fails to disclose means for filtering modules to generate a list of modules as asserted by the Examiner. See Office Action at page 8. The Examiner asserts that this limitation is found in Anuff at col. 14, lines 10-14. However, this portion of Anuff actually reveals that Anuff completely fails to teach a filter: "A layout page...lists all modules that are available to a user group to which a user belongs." (emphasis added). That is, Anuff teaches only presenting each and every module to a user - exactly the opposite of Applicants' claimed invention which provides a way to filter modules so that users can search for a particular module to facilitate module selection. Thus, Anuff fails to teach, disclose or suggest the limitations found in Applicants' claimed invention, as amended, which includes a means for filtering modules.

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Thus, with respect to both the means for filtering and the means for previewing, the only teaching or suggestion to combine impermissibly comes from Applicants' own disclosure. MPEP §2142.

As Anuff fails to teach, disclose or suggest each and every limitation of Applicants' claimed invention as recited in independent claims 1, 11 and 14, Anuff cannot anticipate the invention and the rejection should be withdrawn. Likewise, incorporating the limitations of dependent claims 4 and 5 (as well as corresponding claim 17) into these claims fails to render them obvious. As such, the rejection under 35 U.S.C. §103, to the extent any such rejection follows the claims by virtue of the present amendments, should also be withdrawn. *A fortiori*, claims 10 and 20, which depend from independent claims 1 and 14 respectively, also rejected under 35 U.S.C. §102(e), are not anticipated nor rendered obvious by Anuff.

V. Rejection under 35 U.S.C. § 103(a).

As stated by the Federal Circuit, "a proper analysis under 35 U.S.C. § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success." *In re Vaeck*, 947, F.2d 488, 493 (Fed. Cir. 1991). In addition, the prior art reference(s) must teach or suggest all of the claim limitations. The teaching or suggestion to combine and the reasonable expectation of success must both be found in the prior art, and not in Applicant's disclosure. *Id* at 493. See also MPEP §2142.

Claims 2-3, 6-9, 12-13, 15-16 and 18-19 stand rejected under 35 U.S.C. § 103(a) as obvious over Anuff. Applicants respectfully traverse the rejection.

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As described above, claims 1, 11 and 14, from which claims 2-3, 6-9, 12-13, 15-16 and 18-19 depend, have been shown to be neither anticipated by, nor rendered obvious in view of Anuff. Therefore, dependent claims 2-3, 6-9, 12-13, 15-16 and 18-19 must necessarily also be neither anticipated by, nor rendered obvious in view of Anuff.

Applicants also traverse the Examiner's characterization of the "sections" of Applicants' claimed invention as a "portal within a portal" and for so easily dismissing Applicants' architecture and organization as obvious in the absence of any supporting references. See Office Action at page 5. The Examiner has, on one hand, stated that the sections found in Applicants' claimed invention are the same as the groups disclosed by Anuff (Office Action at pages 3 and 4). However, with respect to claims 2, 12 and 15, the Examiner then asserts that Applicants' reference to the sections as "sections" is just a matter of semantics and that Applicants' sections are actually portals within a larger portal. Office Action at page 5. To demonstrate how this circular reasoning is illogical, the Examiner's interpretation would render Anuff's own reference to "groups" nugatory.

Thus, even though Anuff distinguishes between a portal (an entry point for access to Internet web sites, col. 1, lines 28-30) and groups (columns that form the layout of the portal, col. 4, lines 6-10) and uses these terms separately, the Examiner uses these two different terms interchangeably to reject Applicants' claimed invention. Taking the Examiner's reasoning to its logical conclusion, if Anuff actually teaches multiple portals instead of a single portal with multiple groups, then notwithstanding all of the other reasons already presented why Applicants' claimed invention is patentable over Anuff, the Examiner must withdraw Anuff as a primary reference because it fails to relate to Applicants' claimed invention which is directed to "a" portal.

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In any event, Anuff clearly fails to teach, disclose, or suggest distinct sections of a portal; rather Anuff teaches only a single portal from which all of the modules of Anuff are accessed. Again, the only suggestion to arrive at Applicants' claimed invention comes from Applicants' own disclosure, which is an impermissible basis for rejection. See MPEP §2142.

Finally, with respect to claims 2, 12, and 15, no where does Anuff teach, disclose or suggest a portal having six specific portals, much less that each of the six portals is directed to providing the specific group of information sources described in Applicants' claimed invention. Rather, the Examiner has generally alleged that it would have been obvious to provide such information sources in view of Anuff, merely asserting that the desirability to have access to such information sources is "well-known," although the Examiner has not provided any references to establish those assertions.

Therefore, as Anuff fails to teach, disclose, or suggest every element of independent claims 1, 11 and 14, a *prima facie* case of obviousness has not been presented and claims 1, 11 and 14 are believed to be allowable. For similar reasons, claims 2-3, 6-10, 12-13, 15-16, and 18-20 which depend therefrom, are also believed to be allowable and the rejection should be withdrawn.

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CONCLUSION

For at least the reasons above, Applicants respectfully request reconsideration of the Application and withdrawal of the outstanding rejections. Applicants respectfully submit that claims 1-3, 6-16, and 18-20 are not anticipated by, nor rendered obvious in view of Anuff, and thus, are in condition for allowance. As the claims are not anticipated by, nor rendered obvious in view of, the applied art, Applicants request allowance of all pending claims in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicants' undersigned representative.

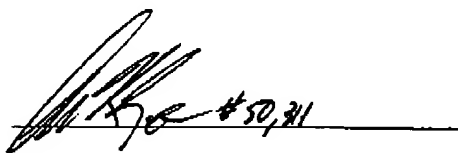
This Amendment/Response has been filed within three months of the mailing date of the Office Action and it is believed that no fees are due with the filing of this paper. The Commissioner is authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

Date: February 3, 2005

Respectfully submitted,

MCNEES WALLACE & NURICK LLC
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By:

A handwritten signature in black ink, appearing to read "Shawn K. Leppo", followed by a horizontal line and the handwritten number "#50,311".

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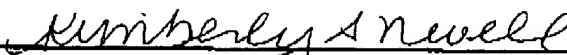
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